

REMARKS

Claims 1-20 were originally presented for examination. With the above amendments, claims 4-6, 8, and 9 have been cancelled without prejudice and claims 1-3, 7, 10-20 have been amended. New claims 21-31 have been added. Thus, claims 1-3, 7, 10-31 are before the Examiner.

In the Office Action of December 8, 1995, the Examiner rejected pending claims 1-20 under 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the invention. The Examiner also rejected claims 1-20 under 35 U.S.C. 103 as being obvious over Payne in view of Travis and/or Muzik in view of Travis or Payne.

A. Claim Rejections -- 35 U.S.C. § 112

With respect to the rejection of the claims under 35 U.S.C. § 112, it is respectfully submitted that the claims as amended conform to the requirements of 35 U.S.C. § 112. In amended claims 2, 3, 13, 14, 15, 17, 18, and new claims 28 and 29, the term "life-like" has been omitted. In these claims, Applicant uses the term "full size, full scale" to particularly point out the claimed invention. For example, a floor tile that would be a "full size, full scale" simulation of a Persian rug measuring 4 feet by 6 feet, may comprise a photographic print of that Persian rug wherein the photographic print is enlarged to a size measuring 4 feet by 6 feet.

Applicant also notes the Examiner's rejection under 35 U.S.C. § 112 with respect to the open ended language of claim 11. In amended claim 11 and new claims 21, 22, and 24, Applicant has provided thickness values that are not open ended. In view of the above, it is respectfully submitted that the particular deficiencies noted by the Examiner under 35 U.S.C. § 112 have been rectified.

B. Claim Rejections -- 35 U.S.C. § 103

The Examiner rejected claims 1-20 under 35 U.S.C. § 103 as being obvious over Payne in view of Travis. Payne discloses a floor tile display device with two parts. The first part is a base member into which a particular style of floor tile may be positioned for display purposes. The second part is a vertical display member wherein a photograph of a room tiled with such a particular style floor tile is positioned. In this manner, a customer can visually see what that particular style of floor tile would look like when a room has been tiled with such a floor tile. It is respectfully submitted that the floor tile display device in Payne fails to disclose or suggest the floor tiles of the present invention. Unlike Payne, the present invention is not a display for the sale of floor tiles. Rather, in the present invention the photographic floor tiles comprise a photographic print and are to be used as the actual flooring surface. In this manner, the present claims are directed to photographic floor tiles that are used as a flooring surface wherein they will be affixed to a floor

and will be subject to foot traffic and other objects passing over the floor tiles. As noted in the specification on page 6, lines 7-9, the floor tiles of the present invention are designed to be used as actual flooring and are to be affixed directly to an existing floor. There is no suggestion or teaching in Payne to use a photographic print as a component of the floor tile itself.

Travis discloses a wall ornament to be mounted on the wall of a bathtub or shower enclosure. The teaching of Travis involves providing a wall ornament that will withstand the moisture and water environment of a bathtub enclosure. While the disclosure of Travis discloses the use of a full scale, full size photograph for use on the wall of a bathtub enclosure, there is no teaching or suggestion to mount such ornament or poster anywhere except the wall of a bathtub enclosure. Certainly there is no teaching or suggestion of any kind to use the enlarged photograph as part of a floor tile or to use the enlarged photograph as a flooring surface that will be subject to foot traffic and other objects passing over the flooring surface. The disclosure of Travis is limited to using an enlarged photograph on the wall of a shower or bathtub enclosure.

It is respectfully submitted that the combination of Payne and Travis does not produce Applicant's claimed invention and would provide nothing more than a floor tile display device with an enlarged photograph of a tiled room. Moreover, there is no suggestion or teaching to provide floor tiles comprising photographic prints that are to be used as an actual flooring

surface as are called for in independent claims 1, 7, 16, and 26. There is also no suggestion or teaching in Payne or Travis to provide a photographic floor tile with a transparent protective coating defining a barrier to prevent injury to the photographic print from foot traffic and other objects passing over the floor tile as is called for in independent claims 1, 7, 16, and 26. Further, the Court of Appeals for the Federal Circuit has made it clear that such suggestion or motivation are required to support an obviousness rejection:

Obviously cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings can be combined only if there is some suggestion or incentive to do so.

ACS Hospital Sys., Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Since the Examiner has not provided the necessary suggestion or motivation to combine these references to produce the claimed invention, the combination of Payne and Travis is improper.

The Examiner also rejected claims 1-20 under 35 U.S.C. § 103 as being obvious over Muzik in view of Payne or Travis. Muzik discloses a laminate for mounting a photographic print. At Column 4, lines 29-30, Muzik discloses that the photograph is backed by a flat mounting base 15. In the next sentence, at column 4, lines 30-34, Muzik also notes as an example, that the photograph may be mounted overhead on a ceiling, vertically on a wall or horizontally on a table or floor. While Muzik states in passing that the photograph may be mounted to a floor, it is respectfully submitted

that Muzik fails to disclose or suggest the use of such a photographic print as a component of a floor tile to be used as a flooring surface. The horizontally-mounted photograph in Muzik would be used for purposes of display (See claim 1 of Muzik), not used as floor tile or flooring surface.

Muzik primarily teaches a particular method of laminating a photograph or graphic print for purposes of displaying such a print. Furthermore, Muzik simply discloses the possibility of mounting a laminated print on a horizontal surface such as a table or floor. However, there is no suggestion that the horizontally-mounted photograph could be used as a floor tile or that it could be used as a flooring surface. In fact, Muzik teaches away from such a use. If one were to use the foam board mounting base 15 as described at column 3, lines 35-45, and mount the photograph for use as a flooring surface, the foam board and photograph would be crushed by foot traffic and the photograph would be injured. In addition, there is no disclosure or suggestion to provide a protective coating as barrier to prevent injury to the photographic print from foot traffic. The only protection disclosed for the transparent sheet is from skin oils resulting from handling (See column 4, lines 35-37). In this regard, the Court of Appeals for the Federal Circuit has warned that:

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of skill in the art.

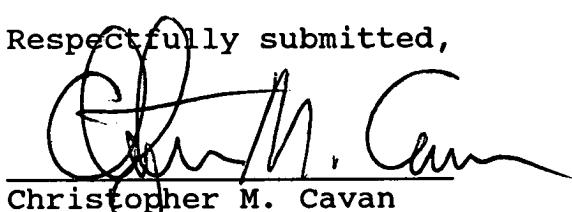
Bausch & Lomb, Inc. v. Barnes-Hinds/Hydrocurve, 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986). As a result, there is no teaching or suggestion in Muzik, or in Muzik in combination with Travis or Payne to provide a floor tile comprising a photographic print as a flooring surface.

Since Payne, Travis, and Muzik, either alone or in combination do not disclose or suggest Applicant's invention, independent claims 1, 7, 16, and 26 are in condition for allowance. As the remaining claims 2, 3, 10-15, 17-25, and 27-31 depend from these independent claims, they are also in condition for allowance.

In conclusion, Applicant has overcome each of the Examiner's rejections. The application is therefore in condition for allowance and early notice to this effect is earnestly solicited.

If, for any reason, the Examiner is unable to allow the application on the next Office Action and feels that a telephone conference would be helpful to resolve any remaining issues, the Examiner is respectfully requested to contact the undersigned attorney at (312) 321-4720.

Respectfully submitted,

  
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